
(2021) 11 DEL CK 0200

In the Delhi High Court

Case No : Civil Suit (COMM) No. 240 Of 2021

Western Digital Technologies, Inc

APPELLANT

Vs

Sumit Pandey And Others

RESPONDENT

Date of Decision : 09-11-2021

Acts Referred:

Trade Marks Act, 1999 — Section 2(1)(zg)

Citation : (2021) 11 DEL CK 0200

Hon'ble Judges : C .Hari Shankar, J

Bench : Single Bench

Advocate : Shwetasree Majumder, Prithvi Singh, Pritika Kohli, Alipak Banerjee

Final Decision : Disposed Of

Judgement

C. Hari Shankar, J

CS(COMM) 240/2021

1. The plaint alleges infringement, by Defendant 1, of the trademarks "WESTERN DIGITAL", "WD", "MY PASSPORT" and "MY CLOUD" (referred to, jointly, in the plaint as the "Western Digital Trademarks").
2. The plaintiff claims to be a world renowned manufacturer of storage devices, media player, routers/switches/bridges, solid state drives, software and mobile applications, manufactured and sold under the Western Digital Trademarks.
3. The plaint alleges that Defendant 1 has registered the domain names "wd-my-passport.com", "wdmypassport.co" and "support-wdc.com". In registering these domain names, the plaint alleges that the defendants are attempting to make it appear that they are associated with the plaintiff by incorporating, in the domain names, the plaintiff's registered trademarks "WD" and "MY PASSPORT".
4. The plaintiff claims to have adopted its corporate name and trademark "Western Digital" in July, 1971. It is further asserted that the plaintiff's logo is its corporate logo and is present on all its products, labels and packaging.

"Western Digital", it is asserted, is the most essential feature of the plaintiff's corporate name. The plaintiff claims to be using the registered trademarks "Western Digital" since 1997, "WD" since 1999 and "MY PASSPORT" since 2008. The plaintiff also asserts that, by dint of long and established user, these trademarks merit being regarded as "well-known trade marks" within the meaning of Section 2(1)(zg) of the Trademarks Act, 1999.

5. The plaintiff provides a tabular depiction of the various registered trademarks of the plaintiff, thus:

Trade Mark

Number

Class

Date

WESTERN DIGITAL

1345682

9

March 18, 2005

WESTERN DIGITAL

2646539

35 & 37

December 20,2013

WD

1349235

9

April 6, 2005

WD

2491589

9

March 7, 2013

1325732

9

December 14,2004

2646540

35 & 37

December 20, 2013

MY PASSPORT GO

3792265

9

March 29, 2018

MY PASSPORT

1695178

9

June 4, 2008

MY CLOUD

2505854

9 & 42

April 2, 2013

MY ELEMENTS

2523270

9, 16, 42

May 1, 2013

These trademarks, it is asserted, continue to remain valid and subsisting in law till date.

6. The plaintiff also claims to be the owner of various websites, the domain names of which contain "WESTERN DIGITAL" or "WD", which are used for marketing and selling "WD" products. Some of these are:

- (i) www.wd.com - created on 25th May, 1994,
 - (ii) www.wdc.com - created on 15th May, 1992,
 - (iii) www.westerndigital.com - created on 21st January, 1998,
 - (iv) www.wdstore.com - created on 23rd May, 2001,
 - (v) www.westerndigital.info - created on 12th September, 2001,
 - (vi) www.westerndigital.biz - created on 28th March, 2002
- and
- (vii) www.westerndigital.asia - created on 17th March, 2008.

7. The plaintiff claims to have received, on 30th April, 2021, an email from one of its customers, informing the plaintiff that it was being attempted to be impersonated and that unauthorized customer support, for the plaintiff's products, was being provided by others for commercial consideration. It is claimed that US \$ 199 was being charged for providing the said support, whereas the plaintiff asserts that it does not charge any sum for customer services provided by it for its products.

8. On enquiry, the plaintiff came to know that Defendant 1 was responsible for the said fraudulent representation using its domain name "www.wd-my-passport.com", and also came across the telephone number of Defendant 1. The plaintiff claims that the domain name manager of the plaintiff, on inquiry, found that the registrant of the aforesaid domain "www.wd-my-passport.com" was Defendant 1, Sumit Pandey. Defendant 1 is claimed to be also owning the domain names "www.wdmypassport.co" and "www.support-wdc.com".

9. On its website <https://www.wdmypassport.co>, it is claimed that Defendant 1 provides basic information on how to use and set up some of the plaintiff's products, including "WD PASSPORT", "MY ELEMENTS", "MY BOOK", "WD BLACK", "MY CLOUD" and "MY CLOUDHOME", thereby misleading customers into believing that Defendant 1 is associated with the plaintiff and its products. It is further claimed that, on these websites, if the "Contact Us" button is clicked, a pop-up opens, which requests for the users' telephone number, so as to enable a call from the technical support team and that once the number is provided, the user receives a phone call from a person impersonating as the plaintiff's authorized representative, who requests for access to the users' system and requires the users to pay the requisite consideration for fixing of any issue or bug in the users' system. As such, the Defendant 1, asserts the plaintiff, is running an unauthorized service centre/support centre for the products of the plaintiff without any licence from the plaintiff in that regard.

10. The plaintiff further asserts that, in fact, WIPO Case No. D2020-2208 was filed against Defendant 1, by M/s. Seagate Technology LLC, titled "M/s. Seagate Technology LLC v. Domains by Proxy, LLC/Sumit Pandey", and that, in the said proceedings, the WIPO passed an order recording the fact that Defendant 1 was operating the domain "www.seagate.support" to mislead users into believing that it was associated with M/s. Seagate Technology LLC. The domain name was, subsequently, transferred, by order of the WIPO, from Defendant 1 to M/s. Seagate Technology LLC. As such, the plaintiff asserts that Defendant 1 is an incorrigible infringer of registered trademarks by creating domains whereunder support and other services, without any authorization, are being provided against monetary consideration.

11. In these circumstances, the plaintiff has approached this Court, by means of the present plaint. The prayer clause in the plaint read thus:

"In view of the facts and circumstances disclosed hereinabove, the Plaintiff most

respectfully prays that this Hon'ble Court may be pleased to pass:

A. A decree of permanent injunction restraining Defendant No. 1, Defendant No. 4 and other such entities which are discovered during the proceedings to have been engaging in carrying out similar fraudulent activities by misusing of the Plaintiff's Western Digital trademarks, from infringing the Plaintiff's registered Western Digital trademarks.

B. A decree of permanent injunction restraining Defendant No 1, Defendant No. 4 and other such entities which are discovered during the proceedings to have been engaging in carrying out similar fraudulent activities misusing the Plaintiff's Western Digital trademarks, from passing off their services as those of the Plaintiff.

C. An order directing a permanent blocking of the domain names registered by Defendant No. 1 and other such domain names which are discovered during the proceedings to have been engaging in carrying out fraudulent activities by infringing the Plaintiff's Western Digital trademarks.

D. An order and decree directing Defendant No. 2, and all others in capacity of principal or agent acting for and, on their behalf, or anyone claiming through, by or under it, to suspend the domain name registrations of Defendants No. 1 as identified by the Plaintiff in the instant suit and other such other domain names that may subsequently be notified by the Plaintiff to be of Rogue Websites which infringe its exclusive rights.

E. An order and decree directing the Defendant No. 3 to issue a notification calling upon the various internet and telecom service providers registered under it to block access to Defendant No. 1's websites or such other websites that may subsequently be notified by the Plaintiff as being Rogue Websites.

F. An order for rendition of accounts of profits illegally earned by Defendant No. 1 and such other Defendants subsequently identified as operating Rogue Websites on account of their infringing activities and a decree for the said amount so found in favour of the Plaintiff.

G. A decree for damages in the sum of Rs. 2,00,01,000/- in favour of the Plaintiff and against Defendant No. 1 on account of the unauthorized use of the impugned mark/device and a decree for the said amount be passed in favour of the Plaintiff.

H. An order for actual and full costs of the present proceedings against Defendant No 1 in favour of the Plaintiff.

I. Such further orders/ reliefs as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case may also be passed in favour of the Plaintiff and against the Defendant."

12. Ms. Majumder, learned Counsel for the plaintiff, submits on instructions that her client does not press prayers F, G and H.

13. By order dated 27th May, 2021, this Court had found, prima facie, infringement by Defendant No. 1, of the plaintiff's trademarks by use of the impugned domain names www.wd-my-passport.com, www.wdmypassport.co and www.support-wdc.com. As such, while issuing notice to the defendants, ad interim relief in terms of a restraint, on Defendant Nos. 1 and 4, from operating the impugned domain names, as well as a direction to Defendant No. 2 to suspend the impugned domain names, was issued.

14. Subsequently, I am informed that the aforesaid domain names www.wd-my-passport.com, www.wdmypassport.co and www.support-wdc.com stand transferred by WIPO in favour of the plaintiff.

15. Summons, as issued by this Court, were served on Defendant No. 1. There has been no appearance on behalf of the said defendant. Apparently, therefore, Defendant No. 1 does not intend to contest these proceedings.

16. Ms. Majumder also suggested that, in order to avoid multiple proceedings, in the event of Defendant No. 1 and/or Defendant No. 4 using the domain names www.wd-my-passport.com, www.wdmypassport.co and www.support-wdc.com with any other domain name extension (other than ".co", ".com"), Defendant No. 2 may be directed to suspend the use of such domain names, on the plaintiff approaching Defendant No. 2 in that regard. I see no impediment in grant of such a direction, as I have already found the use of the domain names www.wd-my-passport.com, www.wdmypassport.co and www.support-wdc.com to be infringing of the plaintiff's registered trademarks. This infringement would, therefore, continue to exist even if these domain names are used with any other domain name extensions.

17. As the impugned domain names www.wd-my-passport.com, www.wdmypassport.co and www.support-wdc.com stand transferred by WIPO in favour of the plaintiff and as the plaintiff is not pressing for damages or costs, nothing survives for adjudication in this plaint. The plaint is, accordingly, decreed in the following terms:

(i) Defendant Nos. 1 and 4 are injuncted from using or operating under any domain name, containing, as its operative part, "wd-my-passport", "wdmypassport" and "support-wdc".

They are also restrained, therefore, from using or operating under any domain names, which contain "wd-my-passport", "wdmypassport" and "support-wdc" with any other domain name extension or any other manner infringing the trademark of the plaintiff.

(ii) In the event of Defendant No. 2 being intimated, by the plaintiff, of use by Defendant No. 1 and/or anyone operating through or on their behalf of domain names containing the characters "www.wd-my-passport", "www.wdmypassport" and "www.support-wdc" with any other domain name extension, they shall proceed to suspend operation of the said domain names forthwith. The plaintiff

would not be required to re-approach the Court in that regard. The right of Defendant No. 2 to seek any clarification or other direction from this Court, in the event of any difficulty in implementing this direction, however, remains reserved.

18. The suit is, accordingly, decreed in the aforesaid terms. Decree-sheet be drawn up by the Registry.

I.A. 6710/2021 (Order XXXIX Rules 1 and 2 CPC)

19. In view of the order passed in the plaint, this application stands disposed of.